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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/000,431	11/30/2001	Hans Burger	10537/185	9197

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EXAMINER

WILLIAMS, ERIC M

ART UNIT

PAPER NUMBER

3681

DATE MAILED: 07/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/000,431

Applicant(s)

BURGER, HANS

Examiner

Eric M Williams

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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DETAILED ACTION

1. This action is in response to the papers filed 04/21//2003 for serial number 10/000,431.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the radial locking recess located in at least one axial end of a transmission shaft shoulder (claim 1), and the support gearing comprising a radial locking recess in at least one axial end (claim 7) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

3. The specification is objected to for defining the term "synchromesh body" (reference numeral 5, 105, 205) in a manner that is repugnant to the usual meaning of the term. See MPEP 608.01 (o)

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-4, 6, 8-14, and 16-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In the claims, Applicant recites, "the radial locking recess located in at least one **axial end of a transmission shaft shoulder** (claim 1, 16), and **the support gearing** comprising a radial locking recess in at **least one axial end** (claim 7)", and asserts (in the remarks submitted 04/21/2003) that page 9 lines 19-22 and page 14 lines 9-11 provide support for such limitations. Neither instance in the specification discloses the above limitations and nowhere in the specification or drawings is there disclosure of the recited recess locations (claim 1 and claim 7).

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled

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in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term “synchromesh body” in claim 5 (line 12) used by the claim to mean “the hub” (reference numerals 5, 105, and 205), while the accepted meaning is, “a component used to synchronize gears at the same speeds before engaging to effect a smooth shift” (www.dictionary.com). The term is indefinite because the specification does not clearly redefine the term, and because claims 1 and 7 have a different meaning for, “synchromesh body”, in the phrase, “the positive locking clutch being free of synchromesh bodies”. The Examiner believes the recitation, “free of synchromesh bodies” (claims 1 and 7) is intended to encompass the ordinary meaning of a “synchromesh body”, nevertheless the meaning of “synchromesh body” as recited in claim 5 line 12 (and referenced with numeral 5, 105, and 205 in the disclosure) is not consistent with the standard meaning of a “synchromesh body.” Since Applicant has given the term synchromesh body two meanings (one in claims 1 and 7, and one in claim 5) all claims are indefinite rendering the scope unascertainable because the intended definition of “synchromesh body” is unclear.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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9. Claims 1-4, 6-14, 16-18, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Kolacz ('151).

Kolacz (Fig. 2) discloses a positive locking clutch connecting a transmission shaft (2) with a one-piece transmission component being an idler gear supported on a gear box Fig. 1(4,5) with an end gearing (27) and supporting a bearing Fig. 1 (7), the clutch comprising; a locking roller element supported in a radial direction (32,33) configured to roll on a synchromesh body (25), a sleeve (36) with an inclined area (unlabeled, Fig. 2), and the locking roller element is displaceable into a radial recess (31) with axial displacement of the sleeve having a radial force component, a roller element support (unlabeled, Fig. 2), an axially aligned support gearing (unlabeled, Fig. 2), the locking clutch is arranged axially between a first transmission component (4) and a second transmission component (5), one locking roller element is provided for each transmission component (Fig. 2) and the locking roller elements of the first transmission component are arranged alternatingly with the locking roller element corresponding to the second transmission component.

Allowable Subject Matter

10. Claims 5, 15, and 19-21 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

Response to Arguments


11. Applicant's arguments with respect to claims 1-21 have been considered but are moot in view of the new ground(s) of rejection.

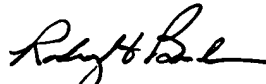
Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric M Williams whose telephone number is 703-305-0607. The examiner can normally be reached on Mon. - Fri. from 7:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles A Marmor can be reached on 703-308-0830.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.


EMW
July 11, 2003


RODNEY H. BONCK
PRIMARY EXAMINER
ART UNIT 3681